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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/482,235	01/13/2000	John L. Wood	OCR-729/756	6715

7590 04/25/2005

Arthur G Schaier
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Waterbury, CT 06721

EXAMINER

COLEMAN, BRENDA LIBBY

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 04/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/482,235

Applicant(s)

WOOD ET AL.

Examiner

Brenda L. Coleman

Art Unit

1624

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 30 March 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 3-5, 8-11, 13-16, 19-24, 26 and 27.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.

Brenda Coleman
Brenda L. Coleman
Primary Examiner
Art Unit: 1624

ADVISORY ACTION

The period for reply continues to run THREE MONTHS from the date of the final rejection. Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a) accompanied by the appropriate fee. The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. A reply within the meaning of 37 CFR 1.113 or a request for a continued examination (RCE) in compliance with 37 CFR 1.114 must be timely filed to avoid abandonment of this application.

The amendment filed March 30, 2005 under 37 CFR 1.116 in reply to the final rejection has been entered, but is not deemed to place the application in condition for allowance. For purposes of appeal, the status of the claims is as follows:

Allowed claim(s): NONE

Rejected claim(s): 3-5, 8-11, 13-16, 19-24, 26 and 27

Claim(s) objected to: NONE

This action is in response to applicant's amendment dated March 30, 2005.

The applicants' incorporation of the material in example 5 onward (pages 20-41) of the disclosure of PCT/IB96/00987 is herein acknowledged.

Response to Arguments

Applicant's arguments filed March 30, 2005 have been fully considered with the following effect:

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1. With regards to the 35 U.S.C. § 102, anticipation rejection of claims 3-5, 8-16, 19-24, 26 and 27 maintained in the last office action, the applicant's arguments have been fully considered but are not found persuasive. The applicant's stated that the applicants have amended the disclosure herewith to include the material incorporated by reference and have also included the required declaration stating that the amendatory material consists of the same material incorporated by reference in the referencing application and requested that the 35 U.S.C. § 102 rejection be withdrawn. However, claims 3-5, 8-11, 13-16, 19-24, 26 and 27 are not described in their entirety within the disclosure of the applicants prior applications and are hence denied benefit of any date prior to December 4, 1998. The instant claims are not described in the applicants priority document and thus are not entitled to benefit of U.S. Application No. 08/817,230 filed June 4, 1997 or any applications prior to this date as it is only completely described in the U.S. Application No. 09/206,082 filed December 4, 1998. Note *In re Scheiber* 199 USPQ 782 regarding 112 compliance for benefit under 35 USC 120. See *In re Hawkins*, 486 F.2d 569, 179 USPQ 157 (CCPA 1973); *In re Hawkins*, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); and *In re Hawkins*, 486 F.2d 577, 179 USPQ 167 (CCPA 1973). Hence, applicants are only entitled to a filing date of December 4, 1998.

Claims 3-5, 8-11, 13-16, 19-24, 26 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Wood et al., Tetrahedron Letters, for reasons of record and stated above.

2. With regards to the 35 U.S.C. § 102, anticipation rejection of claims 3-5, 8-16, 19-24, 26 and 27 maintained in the last office action, the applicant's arguments have been fully considered but are not found persuasive. The applicant's stated that the applicants have amended the disclosure herewith to include the material incorporated by reference and have also included the required declaration stating that the amendatory material consists of the same material incorporated by reference in the referencing application and requested that the 35 U.S.C. § 102 rejection be withdrawn. However, claims 3-5, 8-11, 13-16, 19-24, 26 and 27 are not described in their entirety within the disclosure of the applicants prior applications and are hence denied benefit of any date prior to December 4, 1998. The instant claims are not described in the applicants priority document and thus are not entitled to benefit of U.S. Application No. 08/817,230 filed June 4, 1997 or any applications prior to this date as it is only completely described in the U.S. Application No. 09/206,082 filed December 4, 1998. Note *In re Scheiber* 199 USPQ 782 regarding 112 compliance for benefit under 35 USC 120. See *In re Hawkins*, 486 F.2d 569, 179 USPQ 157 (CCPA 1973); *In re Hawkins*, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); and *In re Hawkins*, 486 F.2d 577, 179 USPQ 167 (CCPA 1973). Hence, applicants are only entitled to a filing date of December 4, 1998.

Claims 3-5, 8-11, 13-16, 19-24, 26 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Wood et al., Journal of American Chemical Society, for reasons of record and stated above.

3. With regards to the 35 U.S.C. § 112, first paragraph rejection of claims 26 and 27 of the last office action, the applicant's arguments have been fully considered but are not found persuasive. The applicant's stated that the applicants have amended the disclosure herewith to include the material incorporated by reference and have satisfied the accompanying formal requirements. However, claims 26 and 27 are not described in their entirety within the disclosure of the applicants' prior applications and are hence denied benefit of any date prior to December 4, 1998. The instant claims are not described in the applicants priority document and thus are not entitled to benefit of U.S. Application No. 08/817,230 filed June 4, 1997 or any applications prior to this date as it is only completely described in the U.S. Application No. 09/206,082 filed December 4, 1998, note the definition of R. Note *In re Scheiber* 199 USPQ 782 regarding 112 compliance for benefit under 35 USC 120. See *In re Hawkins*, 486 F.2d 569, 179 USPQ 157 (CCPA 1973); *In re Hawkins*, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); and *In re Hawkins*, 486 F.2d 577, 179 USPQ 167 (CCPA 1973). Hence, applicants are only entitled to a filing date of December 4, 1998.

Claims 26 and 27 and claims dependent thereon are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, for reasons of record and stated above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda Coleman whose telephone number is 571-272-0665. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Brenda Coleman
Primary Examiner Art Unit 1624
April 15, 2005